

REMARKS

Claims 1-33 are pending in the application. In an Office Action mailed July 26, 2004, the drawings were objected to for a typographical error was present in Figure 2 with regard to the reference numerals. Claims 4, 13, 17, and 26 were rejected under 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-4, 6, 8-12, 14-17, 19-26, 28, and 30-33 were rejected under 35 U.S.C. § 102(b) and Claims 5, 7, 18, 20, 27, and 29 were rejected under 35 U.S.C. § 103(a).

Claims 1, 2, 4, 6, 9, 12-15, 17, 24-26, and 31 have been amended as indicated above to clarify the invention. Amended Figure 2 has been provided for Examiner's review and approval. In view of the foregoing amendments and remarks that follow, applicant respectfully submits that the application is now in condition for allowance.

Objection to the Drawings

The drawings were objected to for in Figure 2, there are 2 occurrences of reference numeral "124." The Examiner requested that the left occurrence of "124" be replaced with reference numeral "126." Applicant thanks Examiner for his careful review of the application. Applicant attaches on separate paper a replacement sheet containing Figure 2 for Examiner's review and approval. The replacement sheet is identified in the top margin with the text "Replacement Sheet" and has been amended to include the reference numeral 126 as requested. Therefore applicant respectfully requests the objection to the drawings be withdrawn.

Claim Rejections Under 35 U.S.C. § 112

Claims 4, 13, 17, and 26 were rejected under 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regards to Claims 4, 17, and 26, the Office Action states that the phrase "sanding pad is adapted to be sandwiched between the frame and the length of unused sandpaper" is unclear. The Office Action recites that when "something is sandwiched, it means there is something on top of the

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AMENDMENTS TO THE DRAWINGS

A replacement sheet containing Figure 2 has been provided for Examiner's review and approval. The replacement sheet is provided on separate paper attached hereto and is identified in the top margin with the text "Replacement Sheet."

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item and beneath the item. In the Figures the sandpaper is beneath the sanding pad but the frame is along side of the sanding pad. However, the sander and the sandpaper together sandwich the sanding pad." (See page 4, paragraph 4 of the Office Action).

Applicant respectfully disagrees with this characterization of the embodiment illustrated in the Figures. For instance, referring to Figure 1, it is apparent that the sanding pad (110) is sandwiched between the frame (126) and the length of unused sandpaper (108) such that the frame (126) is on top of the sanding pad (110) and the unused sandpaper (108) is beneath the sanding pad (110). Therefore, applicant asserts that the language of Claims 4, 17, and 26 is accurate and particularly points out and distinctly claims the subject matter which applicant regards as the invention. Therefore applicant respectfully requests that the 35 U.S.C. § 112 rejections of Claims 4, 17, and 26 be withdrawn.

With regard to Claim 13, the Office Action asserts that the language "the sanding pad is separate from the sander" is unclear. Applicant respectfully traverses. However, inasmuch as Claim 13 has been amended, and since the amendments resulted in the removing of the language "the sanding pad is separate from the sander," applicant submits that the 35 U.S.C. § 112 rejection of Claim 13 is now moot. Accordingly, applicant requests that the 35 U.S.C. § 112 rejection of Claim 13 be withdrawn.

Claim Rejections Under 35 U.S.C. § 102(b)

Claims 1-4, 6, 8-12, 14-17, 19-26, 28, and 30-33 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,083,091 issued to Anderson (hereinafter "Anderson"). Applicant respectfully disagrees with the foregoing rejections.

It is a well-settled axiom of patent law that in order to anticipate a claim, a reference must teach each and every element of that claim. Each and every element of a claim must either be

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expressly or inherently described in a prior art reference.¹ Thus, if every element of the claim is not described or suggested by the reference, the claim cannot be rejected under 35 U.S.C. § 102(b) as being anticipated by the prior art. Further, the elements described or suggested in the reference must be arranged as required by the claim, although the terminology need not be identical.²

1. Rejections Based on Anderson for Claims 1-4, 6, and 8-12

As noted above, Claims 1-4, 6, and 8-12 stand rejected as being anticipated by Anderson. Applicant respectfully disagrees. Applicant respectfully notes that Anderson fails to teach or suggest a frame adapted to couple to a sander having a first sanding pad, a second sanding pad coupled to the frame, and a sandpaper dispensing assembly for selectively dispensing a length of unused sandpaper to extend over the second sanding pad as generally recited in Claim 1. In contrast, Anderson teaches the use of only a single sanding pad associated with a sander and extending the sandpaper over that sanding pad, and therefore does not teach or suggest the use of two sanding pads or extending the sandpaper over the second pad as recited in Claim 1. Accordingly, applicant respectfully submits that the rejection of Claim 1 under 35 U.S.C. § 102(b) be withdrawn.

Claims 2-4, 6, and 8-12 depend from Claim 1. Therefore, for at least the same reasons argued above for Claim 1, dependent Claims 2-4, 6, and 8-12 are also not anticipated by Anderson. Further, dependent Claims 2-4, 6, and 8-12 are also submitted to be allowable because they include additional subject matter not taught or suggested by the cited and applied references, particularly when these recitations are considered in combination with the recitations of the claims from which they depend.

For instance, Claim 2 recites a sandpaper dispenser "wherein the frame includes a tray portion, the tray portion adapted to receive the first sanding pad upon a first surface of a wall

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

² *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

of the tray and the second sanding pad on an opposite surface of the wall." Anderson does not teach or suggest a frame having a tray portion, nonetheless a tray portion for receiving a first sanding pad upon a first surface of a wall of the tray and a second sanding pad on an opposite surface of the wall as claimed by applicant. Therefore, applicant submits that Claim 2 is allowable over Anderson for at least these reasons in addition to those stated above with regard to Claim 1.

As another example, Claim 4 recites "wherein the second sanding pad is coupled to the frame such that the second sanding pad is adapted to be sandwiched between the frame and the length of unused sandpaper when the length of unused sandpaper is extended over the second sanding pad." Anderson does not teach or suggest sandwiching the second sanding pad between the frame the sandpaper since Anderson neither teaches the use of a second sanding pad nor sandwiching a sanding pad between the frame and the sandpaper since Anderson teaches placing the frame "along side of the sanding pad." (See page 4, paragraph 4 of the Office Action). Therefore, applicant submits that Claim 4 is allowable over Anderson for at least these reasons in addition to those stated above with regard to Claim 1.

As still another example, Claim 9 recites "wherein the frame is disposed between the first and second sanding pads when coupled to the sander such that the first sanding pad is spaced from the second sanding pad." Anderson teaches the use of only a single sanding pad, and therefore cannot teach or suggest a frame that is disposed between two sanding pads. Therefore applicant submits that Claim 9 is allowable over Anderson for at least these reasons in addition to those stated above with regard to Claim 1.

As yet still another example, Claim 12 recites "wherein the second sanding pad is disposed below the first sanding pad." Anderson teaches the use of only a single sanding pad, and therefore cannot teach or suggest placing a second sanding pad below a first sanding pad. Therefore applicant submits that Claim 12 is allowable over the prior art for at least these reasons in addition to those stated above with regard to Claim 1.

In a further example, Claim 13 recites a frame which "covers a majority of a bottom surface of the first sanding pad." In contrast, Anderson teaches a frame which is

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displaced "along side of the sanding pad." (See page 4, paragraph 4 of the Office Action). Therefore Anderson does not teach or suggest a frame which covers a majority of the a bottom surface of the first sanding pad as recited in Claim 13. Therefore applicant submits that Claim 13 is allowable over Anderson for at least these reasons in addition to those stated above with regard to Claim 1.

2. Rejections Based on Anderson for Claims 14-17, 19, and 20-23

As noted above, Claims 14-17, 19, 20-23 stand rejected as being anticipated by Anderson. Applicant respectfully disagrees. Applicant respectfully notes that Anderson fails to teach or suggest a frame coupled to a moving portion of a sander wherein a frame is adapted to hold a sanding pad a predetermined distance away from the moving portion as generally recited in Claim 14. In stark contrast to applicant's claimed embodiment recited in Claim 14, Anderson teaches a frame which couples to the side of the moving portion and which does not hold a sanding pad a predetermined distance away from the moving portion. In fact, the sanding pad is directly engaged with the moving portion in Anderson. Accordingly, applicant respectfully submits that the rejection of Claim 14 under 35 U.S.C. § 102(b) be withdrawn.

Claims 15-17, 19, and 20-23 depend from Claim 14. Therefore, for at least the same reasons argued above for Claim 14, dependent Claims 15-17, 19, and 20-23 are also not anticipated by Anderson. Further, dependent Claims 15-17, 19, and 20-23 are also submitted to be allowable because they include additional subject matter not taught or suggested by the cited and applied references, particularly when these recitations are considered in combination with the recitations of the claims from which they depend.

For instance, Claim 15 recites a "tray portion coupled to the moving portion so as to extend underneath a majority of the moving portion." In contrast, Anderson teaches two clamp brackets which are attached along the side of the sanding pad as stated in the Office Action. (See page 4, paragraph 4 of the Office Action). Therefore, not only does Anderson fail to teach or suggest a tray portion, Anderson also fails to teach or suggest extending the frame

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underneath a majority of the moving portion as recited in Claim 15. Therefore applicant submits that Claim 15 is allowable over Anderson for at least these reasons in addition to those stated above with regard to Claim 14.

In a further example, Claim 17 recites "wherein the frame overlies a majority of a top surface of the sanding pad such that the sanding pad is adapted to be sandwiched between the frame and the length of sandpaper when the length of sandpaper is extended over the sanding pad." In contrast, Anderson teaches placing the frame to the side of the sanding pad as stated in the Office Action (See page 4, paragraph 4 of the Office Action), and therefore does not teach a frame which overlies a majority of a top surface of the sanding pad such that the sanding pad is adapted to be sandwiched between the frame and the length of sandpaper when the length of sandpaper is extended over the sanding pad. Therefore applicant submits that Claim 17 is allowable over Anderson for at least these reasons in addition to those stated above with regard to Claim 14.

3. Rejections Based on Anderson for Claims 24-26, 28, and 30-33

As noted above, Claims 24-26, 28, and 30-33 stand rejected as being anticipated by Anderson. Applicant respectfully disagrees. Applicant respectfully notes that Anderson fails to teach or suggest a frame adapted to couple to a sander having a first sanding pad, sandpaper dispensing means for selectively dispensing sandpaper, and a second sanding pad coupled to the frame, wherein the sandpaper dispensing means is adapted to selectively dispense a length of sandpaper to extend over the second sanding pad as generally recited in Claim 24. In contrast, Anderson teaches the use of only a single sanding pad associated with a sander and extending the sandpaper over that sanding pad. Anderson therefore does not teach or suggest the use of two sanding pads or extending the sandpaper over the second pad as recited in Claim 24. Accordingly, applicant respectfully submits that the rejection of Claim 24 under 35 U.S.C. § 102(b) be withdrawn.

Claims 25, 26, 28, and 30-33 depend from Claim 24. Therefore, for at least the same reasons argued above for Claim 24, dependent Claims 25, 26, 28, and 30-33 are also not anticipated by Anderson. Further, dependent Claims 25, 26, 28, and 30-33 are also submitted to

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be allowable because they include additional subject matter not taught or suggested by the cited and applied references, particularly when these recitations are considered in combination with the recitations of the claims from which they depend.

For instance, Claim 25 recites "wherein the frame is disposed between the first and second sanding pads when the frame is coupled to the sander." In contrast, Anderson teaches only the use of a single sanding pad, and further only teaches placing the frame to the side of a sanding pad as stated in the Office Action. (See page 4, paragraph 4 of the Office Action). Accordingly, Anderson fails to teach or suggest a frame disposed between the first and second sanding pads when the frame is coupled to the sander. Therefore applicant submits that Claim 25 is allowable over Anderson for at least these reasons in addition to those stated above with regard to Claim 24.

In a further example, Claim 26 recites "wherein the second sanding pad is coupled to the frame such that the second sanding pad is adapted to be sandwiched between the frame and the length of sandpaper when the length of sandpaper is extended over the second sanding pad." In contrast, Anderson teaches the use of only a single sanding pad, not two as claimed by applicant. Further, Anderson teaches placing the frame to the side of the sanding pad as noted in the Office Action, (See page 4, paragraph 4 of the Office Action) and therefore does not teach coupling the second sanding pad to the frame "such that the second sanding pad is adapted to be sandwiched between the frame and the length of sandpaper when the length of sandpaper is extended over the second sanding pad." Therefore applicant submits that Claim 26 is allowable over the prior art for at least these reasons in addition to those stated above with regard to Claim 24.

In yet a further example, Claim 31 recites "wherein the frame is disposed between the first and second sanding pads such that the first sanding pad is spaced from the second sanding pad when the frame is coupled to the sander." In contrast, Anderson teaches the use of only a single sanding pad, not two as claimed by applicant. Further, Anderson teaches placing the frame to the side of the sanding pad as noted in the Office Action, (See page 4, paragraph 4 of the Office Action) and therefore does not teach or suggest placing the frame "between the first

and second sanding pads such that the first sanding pad is spaced from the second sanding pad when the frame is coupled to the sander." Therefore applicant submits that Claim 31 is allowable over the prior art for at least these reasons in addition to those stated above with regard to Claim 24.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 5, 7, 18, 20, 27, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of U.S. Patent No. 2,447,518 issued to Marinsky (hereinafter "Marinsky"). Applicant respectfully disagrees with the foregoing rejections.

As is well known, the Office Action bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Claims 5, 7, 18, 20, 27, and 29 depend from either independent Claim 1, 14, or 24. For at least the same reasons stated above for the rejections of Claims 1, 14, and 24 under 35 U.S.C. § 102(b), applicants assert that Anderson does not teach or suggest each recited element of Claims 1, 14, and 24. Likewise, applicant asserts that Marinsky fails to teach or suggest at least the same elements not taught or suggested by Anderson. Accordingly, applicant submits that neither Anderson, nor Marinsky, individually or in combination, teach or suggest all the claim limitations of Claims 1, 14, and 24. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Accordingly, applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of Claims 5, 7, 18, 20, 27, and 29, which depend from allowable Claims 1, 14, and 24, be withdrawn for at least these reasons.

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Information Disclosure Statement

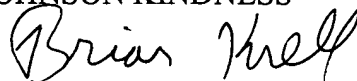
Applicant respectfully notes that an Information Disclosure Statement was filed concurrently with the above-identified application. However, applicant notes that a copy of the Information Disclosure Statement was not returned to applicant with the Office Action indicating that the references were considered. Applicant encloses a copy of the originally filed Information Disclosure Statement herewith for the Examiner's convenience and a postcard receipt indicating receipt by the U.S. Patent and Trademark Office on June 25, 2003. Applicant respectfully requests that a copy of the Information Disclosure Statement be returned with all references considered initialed with the next communication to applicant.

CONCLUSION

In view of the foregoing remarks and amendments, applicant respectfully submits that the present application is in condition for allowance. Reconsideration and reexamination of the application, as amended, and allowance of the claims at an early date is solicited. If the Examiner has any questions or comments concerning this matter, the Examiner is invited to contact applicant's undersigned attorney at the number below.

Respectfully submitted,

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Brian D. Krell

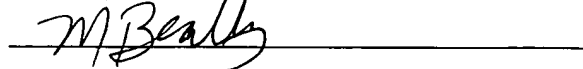
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I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the below date.

Date: October 20, 2004

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